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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/681,071	10/07/2003	Robert Henderson	12406/78	8624
7590 02/24/2005			EXAMINER	
Andrew L. Reibman, Esq. KENYON & KENYON One Broadway New York, NY 10004			PIERCE, WILLIAM M	
			ART UNIT	PAPER NUMBER
			3711	

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/681,071

Applicant(s)

HENDERSON, ROBERT

Examiner

William M Pierce

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

WILLIAM M. PIERCE
PRIMARY EXAMINER

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-22, 33 and 34-47 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

A process claim must contain physical steps that produce a concrete and tangible result. Mental steps used in claims 1-9 and 16-22, such as determining and declaring, do not represent physical steps. These claims appear to fall into the category of a manipulation of abstract ideas.

Further an interpretation of the claims is that they do not expressly or implicitly require performance of any of the steps by a machine (or physical apparatus) and such structure will not be read into the claims for the purpose of the statutory subject matter analysis. This requirement is one that the claims recite a "practical application, i.e., 'a useful, concrete and tangible result.'" *State St. Bank & Trust Co. v. Signature Fin. Group Inc.*, 149 F.3d 1368, 1371, 47 USPQ 2d 1596, 1600-01 (Fed. Cir. 1998).

While a "process" is well recognized as statutory subject matter, not every process falls within the "useful arts" under 101. *Cochrane v. Deener*, 94 U.S. 780, 788 (1877) define "a process is...an act or series of acts, performed upon the subject matter to be transformed and reduced to a different state or thing.

In the instant case, the claims do not require the manipulation of an apparatus, do not result in a concrete and tangible result and fail to transform the subject matter to a something different than existed before the steps were performed.

As to claims 10-15, 33 and 34, merely reciting a "client terminal" and "server" do not make the claims statutory. The terminal and server is considered nonfunctional descriptive material in there is not any functional interrelationship with the way in which the process steps are performed. For the purposes of art, these claims are to be treated as product claims analogous to when a computer program is recited in conjunction with a physical structure, such as a computer memory.

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As to claims 35-41, the steps of selecting are abstract ideas as opposed to physical steps as set forth above with respect claim 1.

Claim Rejections - 35 USC § 112

Claims 1-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, "which game type" and "which game option" are inferential and lacks a proper antecedent. One has to infer that a "multi-feature game of chance" has a plurality of game types and game options. "The plurality of available game types" in claim 1, 8 and 9 lack a proper antecedent. "Determining which game type ...was selected" and "determining which game option ...was selected" are inferential since a step of selecting a game type and option has not been previously recited. "The selected game type" lacks a proper antecedent. "Determining a selected set of digits..." is inferential and unclear since a step of selecting digits has not been previously recited. "The ticket" and "the selected game type" lack a proper antecedent basis. In claim 2, "the plurality of game options", in claims 3-7, "the drawn set of digits" lack a proper antecedent.

The functional steps of claims 10-15 are rejected under 112 as being inferential and lacking proper antecedents for the reasons set forth with respect to claims 1-7.

Lovell

In claim 16, "number drawn" and "a ticket" are inferential and unclear. "The ticket" lacks a proper antecedent.

In claim 23, "a multiplayer option" lacks a clear metes and bounds.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 16-22 and 35-47 are rejected under 35 U.S.C. 102(b) as being anticipated by Lovell.

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Lovell shows determining a game from a plurality of games at 60 having an option of N numbers in which a winner is declared based upon the selected game and the set of digits on the ticket that match a drawn set of numbers.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-15 and 23-32 rejected under 35 U.S.C. 103(a) as being unpatentable over Lovell in view of Pick 3 and Win a Million.

As to claims 2-7 and 23-32, while Lovell alternatively awards players for guessing numbers in sequence and not in sequence (col. 5, ln. 62-col. 6, ln. 9), it is unclear whether or not this is an option for the players. Pick 3 shows that it is old and well known in lottery games to allow the player to guess whether his numbers will be selected in sequence or not. To have allowed a player to have selected an option that his numbers appear in any order would have been obvious as taught by Pick 3 in order to allow a player to vary the play and payouts of the game. As to claims 8 and 9 the number of digit available is considered an obvious matter of choice. See Win a Million. To have allowed players in Lovell to select only one or three numbers would have been obvious in order to make the game easier for a player to win. As to claims 10-15, These claims are rejected for the reasons set forth above with respect to claims 1-9. Additionally, the use of client terminals and servers to administer lottery games as is now being called for in claim 10 is old and well known.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Bergeron, Muller, Gonzalez, De Souza and Meyer show lottery games.

Any inquiry concerning this communication and its merits should be directed to William Pierce at E-mail address bill.pierce@USPTO.gov or at telephone number (571) 272-4414.

For **official fax** communications to be officially entered in the application the fax number is (703)


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872-9306.

For **informal fax** communications the fax number is (703) 308-7769.

Any inquiry of a general nature or relating to the **status** of this application or proceeding can also be directed to the receptionist whose telephone number is (703) 308-1148.

Any inquiry concerning the **drawings** should be directed to the Drafting Division whose telephone number is (703) 305-8335.


WILLIAM R. FERGUSON
PATENT EXAMINER